

### **REMARKS**

Claims 89, 92, 101, 104, 107, 110, 113, 116, 119, 122, 125, 128, 131, 134, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 191, 194, 197, 200, 203, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260-262, 265-276, 279-285, 307, 309-310, and 312 are currently pending in the application. Claims 95, 98, 137, 140, 185, 188, 236, 263, 264, 277, 278, 301, 303, 304, 305, 306, 313, 315, 319, and 327 have been canceled. Claims 89, 92, 101, 104, 107, 110, 113, 113, 119, 122, 125, 134, 146, 149, 161, 164, 167, 170, 173, 182, 194, 197, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260, 261, 266, 269, 285, and 307 have been amended. Applicant requests reconsideration of the application in light of the following remarks.

#### **Request to Admit the Amendment**

Applicant believes that the foregoing amendment complies with the Examiner's requirement of form and further believes that this amendment presents the rejected claims in better form for appeal. Pursuant to 37 C.F.R. § 1.116(a), Applicant requests the Examiner admit the amendment. However, even if the Examiner decides not to admit the amendment under 37 C.F.R. § 1.116(a), Applicant respectfully requests the Examiner admit the amendment pursuant to 37 C.F.R. § 1.116(b). The foregoing amendment is necessary to sufficiently define the invention described in the claims, and provides the necessary support in accordance with 35 U.S.C. 112, first paragraph. The present amendment was not previously presented because Applicant had not arrived at an understanding of what the Examiner considered to be supported by the original disclosure. Upon these good and sufficient reasons for why the amendment is necessary and was not earlier presented, Applicants request the Examiner admit the amendment pursuant to either 37 C.F.R. § 1.116(a) or 37 C.F.R. § 1.116(b).

**Objections to the Specification**

The specification has been objected to for containing informalities. Applicants have amended the specification to address the Examiner's concerns by deleting the material that the Examiner indicated as not being supported by the original disclosure. In fact, the paragraph on page 10 that was objected to by the Examiner has been changed back to its original form. Applicant respectfully requests that the Examiner withdraw the objection to the specification.

**Objections under 35 U.S.C. 132 - New Matter**

The previously submitted amendment has been objected to under 35 U.S.C. 132 for allegedly introducing new matter into the disclosure. Although Applicant disagrees with the Examiner's assessment that new matter has been entered, Applicant has amended the specification as suggested by the Examiner. Applicants respectfully request that the Examiner withdraw the objection under 35 U.S.C. 132.

**Indication of Condition for Allowance**

Applicant wishes to thank the Examiner for the indication of condition for allowance for the above referenced application but for the few formal matters. Applicant believes that all formal matters have been resolved, that the application is in condition for allowance, and respectfully requests the same.

In particular, the Examiner has indicated that all of the claims except for claims 301, 303-306, 313, 319, and 327 would be allowable if the rejection under 35 U.S.C. 112, first paragraph were overcome, along with the minor informalities in the specification discussed above. Therefore, claims 301, 303-306, 313, 319, and 327 have been canceled.

This amendment resolves the remaining informalities and overcomes the rejections by amending or canceling the rejected claims. Therefore, the remaining claims are considered to be allowable. Notice thereof is earnestly requested. Furthermore, with the claims in condition for allowance, it is requested that the interference proceedings be invoked.

**Rejections under 35 U.S.C. §112**

Claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 134, 137, 140, 146, 149, 158, 161, 164, 167, 170, 173, 182, 185, 188, 194, 197, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260-285, 301, 303-307, 309, 310, 312, 313, 315, 319, and 327 stand rejected by the Examiner under 35 U.S.C. 112. In accordance with this rejection, the claims have been amended to comply with the examiner's suggestions and are now believed to conform with Section 112. Applicants respectfully request that the rejection of claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 134, 137, 140, 146, 149, 158, 161, 164, 167, 170, 173, 182, 185, 188, 194, 197, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260-285, 301, 303-307, 309, 310, 312, 313, 315, 319, and 327 under 35 U.S.C. § 112 be withdrawn.

**“stable”**

Although the Examiner states that the term stable “was not included in the original disclosure, it is clear that Applicant’s original disclosure does have the term “stable”. Applicant described its preprints or premixed compositions as being “stable” in the priority document patent to McClain (‘145) at column 1, lines 41-44 and lines 64-66; column 2, lines 15-18, and column 3, lines 49-51. The term “stable” corresponds in meaning to the term “mutually compatible” that has been deleted

or replaced by the term "stable" in the claims in which the term "mutually compatible" was previously recited. The term "stable" has been substituted for the terms "mutually compatible" and "compatible". The term "stable" is supported by the original disclosure of the '145 patent to McClain, and taken in context has a similar meaning to the term "mutually compatible". Therefore, the rejection under 35 U.S.C. § 112, first paragraph for the term "stable" has been obviated and should be withdrawn.

A nexus in the meaning of the terms "stable" and "mutually compatible" has been shown in the immediately previous response by the Applicant. However, it is repeated here for convenience. To establish the similarity of the replacement term "stable", the meaning of "mutually compatible" will be set forth. The term "compatible" is defined by the American Heritage Dictionary of the English Language, Fourth Edition as (see [dictionary.reference.com/search?q=compatible](http://dictionary.reference.com/search?q=compatible)):

1. Capable of existing or performing in harmonious, agreeable, or congenial combination with another or others.
2. Capable of orderly, efficient integration and operation with other elements in a system with no modification or conversion required.
3. Capable of forming a chemically or biochemically stable system.

"Mutually" compatible means the components are compatible with each other. The compatibility of the components in paint and their resulting stable mixture has long been a concern for paint manufacturers. Instable paint is highly undesirable. Those of ordinary skill in the paint industry understand the meaning of the terminology "mutually compatible." One example of this understanding is found in the Tsuei reference cited by the Examiner (U.S. Patent 5,643,669). Tsuei explains at col. 6, lines 20-26, "'compatible' means that the component does not cause adverse affects to the curable composition (e.g. precipitation, flocculation, or other separation of the components), or to the cured coating (e.g., disruption of film continuity, phase separation, or

loss of adhesion to the backing)." This is a conventional meaning for the term as it is used in the paint art.

Applicant described its preprints as being "stable" in the priority document patent to McClain ('145) at column 1, lines 41-44 and lines 64-66; column 2, lines 15-18, and column 3, lines 49-51. This definition is consistent with the dictionary definition of "compatible" set forth above. It is also consistent with the dictionary definition of "stable".

The American Heritage Dictionary of the English Language, Fourth Edition defines "stable" as (see [dictionary.reference.com/search?q=stable](http://dictionary.reference.com/search?q=stable)):

1.   a.   Resistant to change of position or condition; not easily moved or disturbed.
- b.   Not subject to sudden or extreme change or fluctuation.
- c.   Maintaining equilibrium; self restoring.
2.   Enduring or permanent.
3.   a.   Consistently dependable; steadfast of purpose.
- b.   Not subject to mental illness or irrationality.
4.   Physics: Having no known mode of decay; indefinitely long lived. Used of atomic particles.
5.   Chemistry: Not easily decomposed or otherwise modified chemically.

To be stable, the components are inherently compatible. If they were not compatible, they would by definition not form a chemically stable system. Thus, Applicant conveys in the McClain ('145) patent to one skilled in the art of paint that Applicant had possession of the invention at the time the McClain ('145) patent was filed.

The description in the specification of McClain ('145) also provides a definition for "stable" that coincides with the dictionary definitions set forth above and "suggests" freedom from "colloidal instability" and flocculation. That is, the description in the McClain ('145) patent: states that the "compositions ... exhibit stable characteristics during storage in their respective reservoirs"; discusses a specific way to enable a composition of the present invention "to maintain a uniform distribution of the solid throughout its volume"; states that "four premixed aqueous compositions ... are sufficiently stable to be utilized at the point of sale"; and states that the "four above-discussed formulations have been determined to be stable and free from settling when stored in reservoirs for extended periods". See McClain ('145) at column 1, lines 41-44 and lines 64-66; column 2, lines 15-18, and column 3, lines 49-51 and corresponding portion of the present application. The prepaints of McClain '145 are also stable when mixed to form usable paint.

Therefore, the present application is considered to have support for the term "stable" and sufficient description for showing that the term "stable" as used in the original disclosure corresponds in meaning to the term "mutually compatible" as used by the allegedly interfering patent. Nevertheless, the term "mutually compatible" has been deleted or replaced by the term "stable", which has explicit antecedent basis as required by the Examiner and as set forth above. Therefore, the rejections based on the term "stable" should be withdrawn.

**"at least one of the prepaint composition comprising at least one of calcined clay, silica, diatomaceous earth, ground limestone and mixtures thereof"**

The claims have been amended to include only the flattening agents/extenders that are explicitly included in Applicant's original disclosure for the particular prepaints or premixed compositions. Therefore, the rejection under 35 U.S.C. 112, first paragraph based on a longer list of components than explicitly applied to particular prepaints or premixed compositions has been overcome.

**“prepaints”**

The claims have been amended to replace the terms “prepaint” and “prepaints” in combination with other terms by the appropriate terms “premixed aqueous composition(s)”, “premixed pigment composition(s)”, and variations thereof to assure explicit antecedent basis for the claim language. Therefore, the rejections under 35 U.S.C. 112, first paragraph based on the term “prepaint” has been overcome.

**“adsorbed”**

Claims referring to “adsorb” or “absorb” were canceled since the original disclosure does not explicitly discuss the mechanism described by these terms. Applicant holds that adsorption and absorption are inherent in the compositions of the present invention. However, to obtain timely allowance of the base claims, Applicant has canceled all claims that recite details of absorption or adsorption. Therefore, the rejections under 112, first paragraph for including these term has been overcome.

As may be appreciated, the above described ways in which the various terms objected to have been shown to be supported or have been replaced by other terms that mean the same thing using alternative wording that is explicitly supported by the original specification.

**Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

### **Claims**

Claims 301-303, 306, 313, 319 and 327 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuei (U.S. Patent No. 5,643,669, hereinafter "Tsuei").

Claims 301, 303-306, 313, 319 and 327 have been canceled without traverse to obtain immediate allowance of the allowable subject matter of the non-canceled claims. Claim 302 was canceled previously. The rejection of claims 301-303, 306, 313, 319 and 327 is, therefore, overcome.

Applicants respectfully request that the obviousness rejections of claims 301-303, 306, 313, 319 and 327 be withdrawn.

### **Indication of Allowable Subject Matter**

The Examiner indicated the allowability of the scope and subject matter of all the claims that remain in this application. That is, the claims that were rejected only under 35 U.S.C. 112, first paragraph, (which could be amended to recite basically the same invention as before using terms that were explicitly supported in the original disclosure), were amended to overcome the 112, first



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paragraph rejection. Thus, the form of the claims required by the Examiner has been provided by this response.

The rejected claims have been amended or canceled in order to make this application allowable. Applicant reserves the right to file a continuation application to pursue the matter of any canceled claims.

#### **Regarding Doctrine of Equivalents**

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

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**CONCLUSION**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is requested that a one-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$60.00 be charged to Deposit Account 19-0513.

The amendments herein added no new independent and no new dependent claims, resulting in no fees due.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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By



David E. Allred  
Reg. No. 47,254

**SCHMEISER, OLSEN & WATTS LLP**  
18 East University Drive, #101  
Mesa, AZ 85201  
(480) 655-0073